

B. REMARKS

The Examiner is thanked for the performance of a thorough search and for the telephone interview conducted with Attorneys Edward Becker and Craig Holmes on November 2, 2005.

By this amendment, Claims 1-31 and 33 have been amended. Hence, Claims 1-38 are pending in this application. The amendments to the claims do not add any new matter to this application and are fully supported in the specification. For example, the amendment clarifying that a failure prevents the first participant from performing any of the one or more functions assigned to the first participant is supported at least at Page 7, lines 12-15 of the specification. The amendment specifying that the first participant communicates with the second participant to indicate that the second participant has been designated to perform the one or more functions if the one or more handoff criteria are satisfied is supported at least at Page 14, line 19, through Page 17, line 13 and FIGS. 3C and 4. This portion of the specification and these figures describe how a master participant promotes a slave participant to an associate master participant and then how the associate master participant takes over as master participant. All issues raised in the Office Action mailed August 19, 2005 are addressed hereinafter.

OBJECTION TO SPECIFICATION

The specification was objected to on the basis that the related application information on Page 1 is incomplete. As discussed during the telephone interview, a Preliminary Amendment was filed on February 27, 2005 to provide the related application details. The Examiner indicated during the telephone interview that the file history contains the Preliminary Amendment. In view of the Preliminary Amendment previously filed, reconsideration and withdrawal of the objection to the specification is respectfully requested.

REJECTION OF CLAIMS 1-30 UNDER 35 U.S.C. § 101

Claims 1-30 were rejected under 35 U.S.C. § 101 on the basis that the claimed inventions are directed to non-statutory subject matter.

With respect to Claims 1-15, the stated basis for the rejection is that the language of the claims raises a question as to whether the claims are directed to merely an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The Office Action states that the claims are not concrete since, if one of ordinary skill performed the method, they would not be assured repeatable results would occur. The Office Action also states that the claims are not tangible since the steps of the method do not require use of hardware to accomplish the steps.

Claims 1-15 have been amended to recite a computer-implemented method for assigning functions between participants in a communications arrangement. The Specification at Page 1 defines “participant” as “any device or mechanism that exchanges data with other devices or mechanisms over a communications medium.” Thus, Claims 1-15 are directed to a computer-implemented method for assigning functions between devices or mechanisms in a communications arrangement, wherein the devices or mechanisms exchange data with other

devices or mechanisms over a communications medium. As discussed during the telephone interview with the Examiner, a computer-implemented method for assigning functions between devices or mechanisms in a communications arrangement is tied to a technological art. It is also respectfully submitted that the inventions recited in Claims 1-15 also produce a useful, concrete and tangible result, since it is concrete, useful and tangible to designate, prior to a failure of the first device or mechanism, a second device or mechanism to perform the one or more functions. Waiting until after the first device or mechanism has failed to designate a second device or mechanism to perform the one or more functions can disrupt communications while the designation is made.

With respect to Claims 16-30, the stated basis for the rejection is that the claims are not limited to tangible embodiments since the specification describes that a computer-readable medium may include a carrier wave. Claims 16-30 have been amended to recite a computer-readable storage medium. As discussed during the telephone interview with the Examiner, it is believed that inclusion of the word “storage” clarifies that the claims are directed to tangible embodiments.

In view of the foregoing, it is respectfully submitted that Claims 1-30 are directed to statutory subject matter. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-30 under 35 U.S.C. § 101 is respectfully requested.

REJECTION OF CLAIMS 11, 16, 17 AND 31-38 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 11, 16, 17 and 31-38 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The stated basis for this rejection is that the use of the term “a

failure" renders the claims indefinite, since the term "failure" has not been distinctly claimed and it is unclear how the participant has failed. As discussed with the Examiner during the telephone interview, the claims have been amended to clarify that the failure is a failure that prevents the first participant (Claims 11, 16 and 17) or the communications device (Claims 31-38) from performing any of the one or more functions assigned to the first participant (Claims 11, 16 and 17) or the communications device (Claims 31-38). In view of the claim amendments made herein, it is respectfully submitted that the meaning of the term "failure" is now clear. Accordingly, reconsideration and withdrawal of the rejection of Claims 11, 16, 17 and 31-38 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

REJECTION OF CLAIMS 1, 4, 5, 8, 9, 11, 13-16, 19, 20, 23, 24, 26, 28-35 AND 38 UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 1, 4, 5, 8, 9, 11, 13-16, 19, 20, 23, 24, 26, 28-35 and 38 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 4-7, 14, 16, 17, 20, 21, 28, 29 and 38 of co-pending U.S. Patent Application No. 10/052,019. A proper terminal disclaimer complying with 37 CFR 3.73(b) is filed herewith. Accordingly, reconsideration withdrawal of the double patenting rejection is respectfully requested.

REJECTION OF CLAIMS 1-38 UNDER 35 U.S.C. § 102(e)

Claims 1-38 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Wang et al.*, U.S. Patent No. 6,745,034 (hereinafter "Wang"). It is respectfully submitted that Claims 1-38, are patentable over *Wang* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, is directed to a method for assigning functions between participants in a communications arrangement that recites:

“assigning, to a first participant from the plurality of participants, one or more functions to be performed by the first participant; prior to a failure of the first participant that prevents the first participant from performing any of the one or more functions assigned to the first participant, designating a second participant from the plurality of participants to perform the one or more functions if any of one or more handoff criteria are satisfied; the first participant communicating with the second participant to indicate that the second participant has been designated to perform the one or more functions if any of the one or more handoff criteria are satisfied; and in response to any of the one or more handoff criteria being satisfied, assigning the one or more functions to the second participant.”

It is respectfully submitted that Claim 1 recites one or more limitations that are not taught or suggested by *Wang*. For example, it is respectfully submitted that the Claim 1 limitation “the first participant communicating with the second participant to indicate that the second participant has been designated to perform the one or more functions if any of the one or more handoff criteria are satisfied” is not taught or suggested by *Wang*. It is understood from the Office Action that the serving communication station, e.g., base station 1 (BS1), is considered to be the “first participant” recited in Claim 1 and that the target communication station, e.g., base station 2 (BS2), is considered to be the “second participant” recited in Claim 1. Given this interpretation of *Wang*, it is respectfully submitted that the Claim 1 limitation “the first participant communicating with the second participant to indicate that the second participant has been designated to perform the one or more functions if any of the one or more handoff criteria are satisfied” is not taught or suggested by *Wang* since in *Wang*, the base stations (BS1, BS2, BS3) cannot communicate with each other. As depicted in FIG. 1 of *Wang*, each base station (BS1,

BS2, BS3) is not within any of the cells (14-1; 14-2; 14-3) of the other base stations (BS1, BS2, BS3).

In view of the foregoing, it is respectfully submitted that Claim 1 recites one or more limitations that are not taught or suggested by *Wang* and is therefore patentable over *Wang*.

CLAIMS 2-15

Claims 2-15 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-15 are patentable over *Wang* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-15 recite additional limitations that independently render them patentable over *Wang*.

CLAIMS 16-30

Claims 16-30 recite limitations similar to Claims 1-15, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 16-30 are patentable over *Wang* for at least the reasons set forth herein with respect to Claims 1-15.

CLAIMS 16-30

Claims 16-30 recite limitations similar to Claims 1, 4, 8, 9, 11, 10, 12 and 13, respectively, except in the context of communications devices. It is therefore respectfully submitted that Claims 16-30 are patentable over *Wang* for at least the reasons set forth herein with respect to Claims 1, 4, 8, 9, 11, 10, 12 and 13.

In view of the foregoing, it is respectfully submitted that Claims 1-38 are patentable over *Wang*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-38 under 35 U.S.C. § 102(e) as being anticipated by *Wang* is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Edward A. Becker
Reg. No. 37,777
Date: November 21, 2005

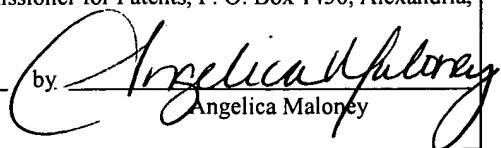
2055 Gateway Place, Suite 550
San Jose, CA 95110
Phone: (408) 414-1204
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on November 21, 2005

by



Angelica Maloney